

08/16/2004

10:59

LSI LOGIC LEGAL IP → 917038729306

NO.008 0001

LSI

FAX

RECEIVED
CENTRAL FAX CENTER

AUG 16 2004

OFFICIAL

LSI Logic Corporation
Legal Department - IP
1621 Barber Lane, MS D-106
Milpitas, CA 95035Date August 16, 2004Number of pages including cover sheet 3

To: US PTO, Before Final

TC 2822

Fax No. 703-872-9306

Phone No.

CC:

From: Connie del Castillo

Intellectual Property Paralegal

Telephone No. (408) 433-7191

Fax No. (408) 433-7460

REMARKS:

☐ Urgent☐ For your review☒ Reply ASAP☐ Please comment

Application Number: 10/643,687
Filing date: August 19, 2003
First named inventor: Sheldon Aronowitz et al.
Attorney docket number: 02-4828/1D

Transmitted herewith for filing via facsimile:

- Amendment in response to the Office Action dated August 6, 2004.

Pursuant to 37 C.F.R. 1.8, I hereby certify that this correspondence is being transmitted by facsimile to the U.S. Patent and Trademark Office on the date indicated below:

Aug 16, 2004

Date

Connie del Castillo

Signature

Connie del Castillo

Please contact us at (408) 433-7191 if you do not receive all pages indicated above or experience any difficulty in receiving this facsimile.

This Facsimile is intended only for the use of the addressee and, if the addressee is a client or their agent, contains privileged and confidential information. If you are not the recipient of this facsimile, you have received this facsimile inadvertently and in error. Any review, dissemination, distribution, or copying is strictly prohibited. If you received this facsimile in error, please notify us by telephone and return the facsimile to us

AUG 16 2004

OFFICIAL

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Sheldon Aronowitz, et al.)
) Group Art Unit: 2822
)
) Examiner: Ida M. Soward
Serial No.: 10/643,687)
) Atty. Docket No.: 02-4828/1D
Filed: August 19, 2003)
)
For: High K Dielectric Gate Material)
Uniquely Formed)
)

RESPONSE TO OFFICIAL ACTION
Restriction/Election Requirement

Hon. Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

This response is presented to the Office Action mailed April 30, 2003, wherein the Examiner required restriction pursuant to 35 U.S.C. §121. Election is hereby made, *with traverse*, to prosecute Group II, claims 2-9. Please note, however, that Applicant requested deletion of claims 2-5 when filing this divisional application (see section 4, on page 2 of the divisional application transmittal).

Remarks/Arguments

Reconsideration of the restriction is respectfully requested. Restriction is not required by 35 U.S.C. §121, as suggested in the Office Action. Congress wisely granted the *discretion* to restrict applications. According to 35 U.S.C. §121 "... the Commissioner *may* require the application to be restricted...." (emphasis added).

Furthermore, MPEP § 803 lists two criteria that must be present for restriction to be proper:

- 1) The inventions must be independent or distinct as claimed; and
- 2) There must be a serious burden on the examiner if restriction is required.

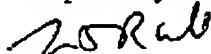
In searching the Group II claims, the class and subclass for the Group I claims will undoubtedly be searched, to ensure that no relevant art is overlooked. For this reason there is no significant burden on the examiner, and certainly no serious burden as required by MPEP §121.

In fact, maintaining the requirement for restriction not only burdens applicants with the additional costs associated with filing and prosecuting separate patent applications, but also requires the examiner to duplicate efforts by examining multiple applications of closely related inventions. Such practice not only wastes public and private funds and Patent Office resources, but also leads to the possibility of inconsistent examinations of closely related inventions. Accordingly, applicants respectfully request that the examiner reconsider and withdraw the restriction requirement.

In light of the foregoing, applicants respectfully submit that a full and complete response to the Office Action is provided herein, and request that the application proceed to examination.

In the event this response is not timely filed, applicants hereby petition for the appropriate extension of time and request that the fee for the extension along with any other fees which may be due with respect to this paper be charged to deposit account 12-2252.

Respectfully Submitted,



Timothy R. Croll
Reg. No. 36,771
(408) 433-7625
LSI LOGIC CORPORATION
1621 Barber Lane
M/S D-106
Milpitas, CA 95035-7451

Date: August 13, 2003